

REMARKS

Indication of allowable subject matter of claims 9 and 22 is appreciated.

According to the Office Action, claims 1 – 8 and 18 – 21 are rejected under 35 USC 103(a) as being obvious over US Patent 6,993,334 (Andrus). In response, the rejections are respectfully traversed as lacking sufficient factual support and failing to establish a prima facie case of obviousness in accordance with the established cases and statutory law.

It is respectfully submitted that the examiner failed to establish a prima facie case of obviousness. It is a well settled law that the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Among other things, Andrus fails to teach or suggest Applicant's feature of "a pre-configured nearest-neighbor table" as recited in claim 1. The examiner alleges that Andrus discloses this feature in Figures 3 and 4, and at col. 9, line 3 – col. 11, line 25. Applicant's representative respectfully disagrees.

Andrus merely teaches that "the process starts at step 310, where a list of neighbor access points is determined. These can be determined by access terminal search, access point transmission or a combination of both" (see col. 9, line 10 et seq.). Nowhere does he mention a pre-configured nearest-neighbor table. Hence, it is submitted that Andrus is deficient in disclosing this feature of Applicant's claimed invention.

Furthermore, it is admitted in the Office Action that Andrus fails to teach or suggest Applicant's feature of "where each record includes at least a first field identifying a nearest neighbor AP and a second field identifying said nearest neighbor AP's channel of operation" as recited in claim 1. It is unclear whether the examiner relies on personal knowledge of the facts or those of a skilled artisan in his statement. If this is the case, then "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Kotzab*, 1371. The MPEP provides guidelines for relying on official notice and personal knowledge, which the Examiner did not follow in this case:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)) ...

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

See MPEP §2144.03. If the rejection is maintained, it is respectfully requested that the examiner provide an affidavit stating facts within his personal knowledge or an affidavit by a skilled artisan.

At least for the above reasons, it is submitted that the rejection of claim 1 has been overcome and can no longer be sustained. Withdrawal of the rejection and allowance of claim 1 is respectfully requested.

Independent claim 18 contains, among other things, the features of claim 1 as discussed above. Applicant essentially repeats the same argument as above and asserts that claim 18 is also allowable for the same reasons as claim 1.

Claims 2 – 8 and 19 – 21 depend from independent claims 1 and 18 respectively, which have been shown to be allowable over the prior art references. Accordingly, claims 2 – 8 and 19 – 21 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein. It is submitted that the rejection of claims 2 – 8 and 19 – 21 has been overcome. Hence, withdrawal of the rejection and allowance of the claims are respectfully requested.

An earnest effort has been made to be fully responsive to the examiner's correspondence and advance the prosecution of this case. In view of the above amendments and remarks, it is believed that the present application is in condition for allowance, and an early notice thereof is earnestly solicited.

Please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,

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